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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/646,213 | 05/07/96 | AFANASENKO | N AFANASENKO |

EDWARD R FREEDMAN
COLLARD AND ROE PC
1077 NORTHERN BOULEVARD
ROSLYN NY 11576

QM41/1103

| EXAMINER | |
|----------|--------------|
| CLARK, J | |
| ART UNIT | PAPER NUMBER |
| 3733 | |

DATE MAILED: 11/03/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/646,213

Applicant(s)

Afanasenko et al.

Examiner

Jeanne Clark

Group Art Unit

3733



☒ Responsive to communication(s) filed on Aug 19, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 11-13 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 112

1. Claims 11-13 are rejected as failing to define the invention in the manner required by 35 U.S.C. § 112, second paragraph.

In regard to claim 11, the use of the term "said" for a person or their anatomical parts thereof is objected to because use of the term "said" is reserved to claimed elements of the instant invention, e.g., "said trunk" (line 15). By reserving the term "said" for claimed elements, the claim is clear and unambiguous about which elements are part of the instant invention and which elements refer to a person or a user, e.g., distinguishing between "said arm" of a linkage of the invention and "said arm" of the user. Also, on line 14, "an other" should be --another--.

The remainder of the claims are necessarily rejected as being based on a rejected claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradstreet (U.S. Patent No. 807,908) in view of Romney (U.S. Patent No. 5,308,305).

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In regard to claim 7, Bradstreet teaches a device comprising supports including waist support 3, shoulder supports 7, hand supports 13, elbow supports 12, knee supports 22 and foot supports (D) and elastic tie-members 4,5,8,11,14,20,21,23 and 27 arranged in "antagonistic pairs", capable of acting independently as claimed and connected to at least two supports (Figures 1,2, page 1 lines 8-34 and page 2 lines 69-79). Bradstreet teaches a device that develops "practically every muscle of the body" wherein the elastic members are located anteriorly and posteriorly on the trunk and limbs (page 1 lines 12-14). Furthermore, Bradstreet teaches a plurality of means (A) for adjusting the tension (Figure 6 and page 1 lines 74-81). Bradstreet discloses the claimed invention except for the position of the adjusting means. Romney teaches that it is known to provide such an adjusting means 70-73,130,131 located between the elastic tie-members and the supports (Figures 5,8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include such an adjusting means, as taught by Romney, in order to provide a convenient means for adjusting the elastic members from the support.

In regard to claim 12, Romney teaches the adjusting means including bands (i.e. releasable anchoring ends 31,33) and a lock 30,32 (column 6 line 65 to column 7 line 7 and column 7 line 66 to column 8 line 17). **In regard to claim 13**, the lock is essentially a conventional buckle.

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Response to Amendment

4. The declarations and exhibits under 37 CFR 1.132 filed August 19, 1998 are insufficient to overcome the rejection of claims 11-13 for several reasons.

First, the declarations and exhibits are unclear if the "Adeli" device is in fact the same apparatus that is being claimed. The declarations fail to make any nexus or connection between the device "Adeli" and the claimed invention.

Second, the declarations are drawn to the METHOD of USING the device called "Adeli" and its effects. However, the claims are drawn towards an apparatus and not the method of use. Claims cannot be distinguished over prior art teaching the same structural elements merely because applicant has discovered a new USE for the claimed apparatus. The applicant should note that in a recent decision the Federal Circuit held that "[a]lthough Schreiber is correct that Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable" (citing In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)). In re Schreiber, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Furthermore, the Federal Circuit held that "[a] reference may be from an entirely different field of endeavor than that of that claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims." In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

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Finally, the declarations do not show that the prior art used in the rejections is incapable of providing the claimed function as alleged by applicant on page 1 of the response filed August 19, 1998. In fact, the declarations do not even mention the art used in the rejections. Comparisons of the invention, in support of a showing of superiority or unexpected results, must be with respect to the closest prior art to have probative value. In re Wright, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). Furthermore, it appears from the declarations that the "Adeli" suit was used as part of a course of treatment including massage, paraffin treatments, laser acupuncture, etc. (See Exhibit F, page 2). Therefore, the record is unclear what results are attributed to the Adeli suit or to the other treatments. Evidence of non-obviousness must be given consideration, but does not mandate a conclusion of non-obviousness. In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); Newell Companies, Inc. v. Kenney Manufacturing Co., 864 F.2d 757, 9 USPQ2d 1417 (Fed. Cir. 1988).

Conclusion

5. This is a Continuing Prosecution Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP


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§ 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne Clark whose telephone number is (703) 308-0063. Beginning April 1, 1998 all correspondence may be addressed to Art Unit 3733.

J Clark
November 2, 1998



JEANNE M. CLARK
PRIMARY EXAMINER